

Notice of Allowability

Application No.

09/477,962

Examiner

Kathleen M Kerr

Applicant(s)

SHEN ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/2/04.
2. ☒ The allowed claim(s) is/are 9,10,12-14,40,41 and 43-45.
3. ☒ The drawings filed on 03 July 2003 and 15 March 2004 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


Kathleen M Kerr
Primary Examiner
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DETAILED ACTION

Application Status

1. In response to the previous Office action on the merits, a non-Final rejection (Paper No. 17, mailed on September 17, 2003), Applicants filed a response and amendment received on March 15, 2004 (non-compliant), September 17, 2004 (non-compliant), and December 2, 2004. Said amendment cancelled Claims 1-3, 21, 42, 71, and 73 and amended Claim 40. Thus, Claims 9, 10, 12-14, 40, 41, and 43-45 are pending in the instant Office action and will be examined herein.

Priority

2. As previously noted, the instant application is granted the benefit of priority for the U.S. Provisional Application No. 60/115,435 filed on January 6, 1999 and 60/118,848 filed on February 5, 1999.

Drawings

3. In response to the previous Office action, some new formal drawings (Figures 1A, 1B, 2, 4, 6A-F, 8C, 9) were filed and have been approved by the Draftsman. Thus, Figures 1A, 1B, 2, 4, 6A-F, 8C, 9 filed March 15, 2004 and Figures 3A-D, 5, 7, 8A, 8B, 10A-B, 11A-D, 12, and 13 filed July 3, 2003 together are considered the formal set of drawings for the instant application.

Withdrawn - Claim Rejections - 35 U.S.C. § 112

4. Previous rejection of Claims 1-3 and 40-45 under 35 U.S.C. § 112, second paragraph, as being indefinite for the term "stringent conditions" is withdrawn by virtue of Applicant's cancellation and/or amendment of said claims.

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5. Previous rejection of Claims 21 and 40-45 under 35 U.S.C. § 112, second paragraph, as being indefinite for the term “a bleomycin” of “a bleomycin analogue” is withdrawn by virtue of Applicant’s cancellation and/or amendment of said claims.

6. Previous rejection of Claims 71 and 73 under 35 U.S.C. § 112, second paragraph as being indefinite for the term “bleomycin gene cluster” is withdrawn by virtue of Applicant’s cancellation of said claims.

7. Previous rejection of Claims 1-3, 21, 40-45, and 71-73 are rejected under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicant’s cancellation and/or amendment of said claims.

8. Previous rejection of Claim 71 under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicant’s cancellation of said claim.

Withdrawn - Claim Rejections - 35 U.S.C. § 102

9. Previous rejection of Claims 1, 40, 41, and 43-45 under 35 U.S.C. § 102(b) as being anticipated by Redenbach *et al.* is withdrawn by virtue of Applicant’s cancellation and/or amendment of said claims.

EXAMINER'S AMENDMENT

10. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Amendments to the Claims

11. The claims, as filed by Applicant on December 2, 2004, have been amended as shown below to reflect the language previously filed by Applicant (on July 3, 2003) and incorrectly rewritten in the claims filed on December 2, 2004. Thus, no authorization is needed for the amendment since it merely corrects a typographical error.

a) Rewrite Claim 14 as follows:

---14. The nucleic acid of claim 9, wherein said nucleic acid further comprises a nucleic acid encoding a protein selected from the group consisting of SEQ ID NO:107, SEQ ID NO:106, SEQ ID NO:102, SEQ ID NO:101, SEQ ID NO:100, SEQ ID NO:98, and SEQ ID NO:97.---

Partial Withdrawal of Restriction Requirement - Rejoinder

12. The restriction requirement of record, mailed August 10, 2001, previously restricted the nucleic acid products from processes of using the nucleic acids to modify a biological molecule (original Claims 46-63) or to make a bleomycin (original Claim 64). Said restriction was traversed in a paper filed by Applicant on December 10, 2001; non-elected claims were subsequently cancelled by Applicant.

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Claim 9 is directed to an allowable nucleic acid product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined and the restriction between these Groups ^{is} ~~herein~~ **WITHDRAWN**. Note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See M.P.E.P. § 804.01.

Since all process claims possibly subject to rejoinder have been previously cancelled by Applicant, no pending claims are herein subject to rejoinder.

Conclusion

13. Claims 9, 10, 12-14, 40, 41, and 43-45 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (571) 272-0931. The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M Kerr
Primary Examiner
Art Unit 1652

February 9, 2005